

R E M A R K S

A. Restriction

The Examiner restricted the claims into three groups as follows:

- Group I: Claims 1-25 and 43-59;
- Group II: Claims 26-29 and 34-42; and
- Group III: Claims 30-33.

A further restriction of the following three species was also imposed for each of Groups I (Claims 1-9, 11-25, 43-51, 54-59), and II (Claims 34-39, 41-42):¹

- i) katanin and the p60 subunit of katanin;
- ii) XKCM1; and
- iii) OP18 polypeptide.

The Examiner did **not** require restriction of the species of the following claims on the basis that they correspond to species (i) katanin and the p60 subunit of katanin:² Claims 10, 52, and 53 (Group I); Claims 26-29, and 40 (Group II); and Claim 30 (Group III).

B. Election

Applicants elect Group I (*i.e.*, Claims 1-25 and 43-59) and species (i) (*i.e.*, katanin and the p60 subunit of katanin), **with traverse**. Applicants' non-election of the remaining groups and species does not narrow the scope of any of the claims within the meaning of *Festo*,³ because non-election of these claims is not related to a "statutory requirements for a patent" but rather is related to the Patent Office's convenience for organizing searches. Applicants reserve the right to prosecute the non-elected claims in another application(s).

¹ Office Action, page 3.

² Office Action, page 3, third full paragraph.

³ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, U.S., No. 00-1543, 5/28/02.

C. Traversal

Applicants traverse the Examiner's restriction of Groups I, II, and III, and request rejoinder of Claims 34-42 with Group I's Claims 1-25 and 43-59. Applicants also traverse restriction of species i-iii and request their rejoinder in each of the groups, as further explained below.

1. Traversal of restriction of Groups I, II, and III

Applicants **traverse** the Examiner's restriction of Groups I, II, and III, and request rejoinder of Claims 34-42 with Group I's Claims 1-25 and 43-59. The Examiner's grouping is based on an erroneous reading of the claims. Under PCT Rule 13.2, unity of invention is fulfilled

"when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression 'special technical features' shall mean those technical features that define a contribution which each of the claimed inventions, *considered as a whole*, makes over the prior art."⁴

The Examiner argued that Group II's technical feature "is the p60 katanin subunit polypeptide product."⁵ This is incorrect with respect to Claims 34-42 (which the Examiner assigned to Group II) since Claims 34-42 are **not restricted** to p60 katanin subunit polypeptide. Indeed, the Examiner recognized that Claims 34-39 and 41 are "**generic**."⁶ Claims 34-42 recite kits that contain microtubule severing proteins. Thus, one feature of Claims 34-42 is the use (in kits) of agents that are microtubule severing proteins. Since this feature, **as a whole**, corresponds to the feature which the Examiner assigned to Group I, Applicants respectfully request that Claims 34-42 be joined with Group I.

2. Traversal of restriction of species i-iii

Applicants **traverse** restriction of species i-iii and request their rejoinder in each of the groups. The Examiner argued that each of the species i-iii "has a different special technical

⁴ Emphasis added.

⁵ Office Action, page 2, fourth and fifth paragraphs.

⁶ Office Action, page 3, third full paragraph.

feature and do not relate to a single general inventive concept."⁷ This argument was based on characterizing the "special technical feature of species i is the p60 subunit of katanin, the special technical feature of species ii is XKCM1, and the special technical feature of species iii is OP18 polypeptide."⁸ However, the Examiner's characterization of the technical features of the species **does not consider** the "contribution which each of . . . [the p60 subunit of katanin, XKCM1, and OP18 polypeptide], considered as a whole, makes over the prior art," as required by PCT Rule 13.2. In particular, the p60 subunit of katanin, XKCM1, and OP18 polypeptide share the common technical feature of being a **polypeptide** for which the **common contribution over the prior art** is that each polypeptide has microtubule severing and/or microtubule depolymerizing activity. In view of this technical relationship which unites the three polypeptides, restricting them into separate species violates PCT Rule 13.2. Accordingly, Applicants respectfully request rejoinder of species i-iii in each of the groups.

CONCLUSION

For the reasons set forth above, it is respectfully requested that (a) Claims 34-42 be rejoined with Group I's Claims 1-25 and 43-59, and (b) species i-iii be rejoined in each of the groups.

Should the Examiner disagree, Applicants elect, **with traverse**, Group I (*i.e.*, Claims 1-25 and 43-59) and species (i) (*i.e.*, katanin and the p60 subunit of katanin). If a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to direct such communications to Maha A. Hamdan at (415) 904-6500.

Signed on behalf of:

Dated: September 3, 2002



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⁷ Office Action, page 4, first full sentence.

⁸ Office Action, sentence bridging pages 3 and 4.